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09/502,313	02/11/2000	Keith Rose	1142	4981

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EXAMINER

CAMPEN, KELLY SCAGGS

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**MAILED**

MAY 09 2005

**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/502,313  
Filing Date: February 11, 2000  
Appellant(s): ROSE ET AL.

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Charles E. Gotlieb  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 7/22/04.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

Examiner notes the applicant has included additional information not relating to the status of the claims, information appropriate for the "Argument" section.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed. The paper filed 03-01-2004 was identified as Amendment B when no amendment was included, in actuality, it was directed to a request for reconsideration and all claims are directed to the originally filed claims. There have been no amendments to the instant application.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

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**(6) Issues**

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Applicant includes procedural issues with the appealable issue. The appeal issue is whether or not the prior art of record have 112 first paragraph basis in the priority documents.

**(7) Grouping of Claims**

The rejection of claims 1-16 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record****(9) Prior Art of Record**

US 2001/0034641A1	D'Amico et al.	10-2001
US 2003/0135457A1	Stewart et al.	07/2003

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**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al. (US 2003/0135457 A1) in view of D'Amico et al. (US 2001/0034641 A1).

Stewart et al. disclose a method and apparatus for providing online financial account services comprising receiving a subscription to open and fund a new deposit

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account online through a web site of a financial institution 10. The customer 20 is directed to the web site of the financial institution by web-based advertising or other links, by a web search engine or by directly entering the site's URL address in a web browser. The web site provides information related to accounts and other services offered by the financial institution (see page 5, paragraph (0057). Stewart et al. disclose that the financial institution 10 can be a bank or any other type of financial or investment services company offering deposit based services and that the deposit account can be a checking or savings account, a certificate of deposit, a money market account or any other suitable financial account (see page 2, paragraph (0016)).

Stewart et al. do not specifically disclose that the financial account to be opened by the customer 10 at the investment services company can be a mutual fund account.

D'Amico et al. disclose prospective customers purchasing shares of a mutual fund by contacting the mutual fund on the Internet, requesting an application and then submitting the completed application along with the appropriate funds to the fund advisor (see page 3, paragraph (0047)).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made, in view of the teachings in D'Amico et al., to allow a customer of the Stewart et al. method, to both open and fund a mutual fund account over the Internet, thereby expanding the customers investment options and enabling the customer to buy and sell mutual fund shares online.

Regarding claims 5 and 13, the examiner takes official notice that a series of linked web pages where the user can create a new account is old in the art (see the

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cited reference to Joseph (US 2001/0034690 A1, paragraph (0039)). In view of this official notice, it would have been obvious to one of ordinary skill in the art at the time that the invention was made, to modify the user interface of the Stewart et al./ D'Amico et al. combination method with linked web pages, so as to utilize a well known and convenient user-friendly interface.

Regarding claims 7, 8, 15 and 16, the examiner takes official notice that scrolling banner and animated banner advertisements are well known in the art of advertising on the web. In view of this official notice, it would have been obvious to one of ordinary skill in the art at the time that the invention was made, to use banner advertising at the users computer interface in the Stewart et al./ D'Amico et al. combination method and thereby avail of an efficient and proven method of advertising on the internet.

**(11) *Response to Argument***

See MPEP 706.02, 2136.01, 2136.02, 2136.03 to define what is prior art. If there is a claim to a provisional application, the effective filing date for that prior art is the filing date of the provisional application. While the applicant claims that they do not have access to the provisional application, that bears no weight in the effective filing date of prior art. The applicable provisional applications have been included as Examiner Appendix A, B and C.

Applicant has made four separate arguments for four issues where the arguments are generally directed to procedural issue, not appealable issues. The real thrust for the argument is "is there 112 1<sup>st</sup> paragraph support for the 103 rejection of claims 1-16. The issue of who is required to provide provisional applications is a procedural issue. Failure of applicant to obtain copies of the provisional applications does not nullify rejection or disqualify the art. Examiner

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maintains the rejection as rejection is based on US Published Applications and not on provisional applications as such. The timeline for the prior art of record is as follows:

US2001/0034641A1 D'Amico et al., filed February 9, 2001:

Claims priority from 60/181580 filed February 10, 2000 included as Appendix A.

Inventors Gregory A. D'Amico and Robert A. Loest.

US2003/0135457A1 Stewart et al., filed/entered National stage September 6, 2002:

National Stage of PCT US00/42416 filed November 3, 2000 (prior to the 30 month date) PCT priority date December 1, 1999 to

US Provisional application 60/168273 (Appendix B) filed December 1, 1999 and

US Provisional Application 60/168276 (Appendix C) filed December 1, 1999

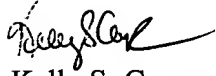
Inventors Whitney Hilton Stewart and Robert L. Hill.

For the above reasons, it is believed that the rejections should be sustained.



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Respectfully submitted,




Kelly S. Campen

April 27, 2005

Conferees

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